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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Rocheux International of New Jersey, Inc.

Serial No. 78262721

Myron Amer, PC for Rocheux International of New Jersey,
Inc.

Kelley F. Boulton, Trademark Examining Attorney, Law Office
102 (Thomas V. Shaw, Managing Attorney).

Before Walters, Chapman and Kuhlke, Administrative
Trademark Judges.

Opinion by Chapman, Administrative Trademark Judge:

On June 16, 2003, Rocheux International of New Jersey,
Inc. (a New Jersey corporation) filed an application to
register on the Principal Register the mark SYNTHETEK for
"synthetic paper" in International Class 16, based on
applicant's claimed date of first use and first use in
commerce of January 1, 1998. Applicant included in its
original application a claim of acquired distinctiveness

under Section 2(f) of the Trademark Act, 15 U.S.C. §1052(f).

In the first Office actions (both dated December 31, 2003), the Examining Attorney refused registration of the mark as merely descriptive of applicant's goods under Section 2(e)(1) of the Trademark Act, 15 U.S.C. §1052(e)(1), and rejected applicant's claim of acquired distinctiveness under Section 2(f) as insufficient. In response, on June 28, 2004, applicant filed an amendment to the Supplemental Register. The Examining Attorney then refused registration on the Supplemental Register under Section 23 of the Trademark Act, 15 U.S.C. §1091, on the basis the applied-for mark is generic and incapable of serving as a source identifier for applicant's goods.

When the refusal to register the proposed mark on the Supplemental Register was made final, applicant appealed to the Board. Both applicant and the Examining Attorney have filed briefs. Applicant did not request an oral hearing.

The issue before the Board is whether the term SYNTHETEK is generic for applicant's identified goods "synthetic paper," and thus, is incapable of serving as a source identifier therefor and hence is unregistrable on the Supplemental Register.

The Examining Attorney's position is that the term "SYNTHETEK" is generic for synthetic paper because consumers "would understand that the applicant's paper is synthetic"; that the evidence shows that "synthetic paper" is a "specific type of paper"; and that "applicant presented the [proposed mark] as a phonetic misspelling, [but] the phonetic equivalent of a generic term is also generic." (Brief, unnumbered pages 3-4.)

During the examination process for this application, the Examining Attorney submitted (i) The American Heritage Dictionary (Fourth edition 2004) definition of "synthetic" as "3b. Prepared or made artificially: synthetic leather. ..."; (ii) photocopies of several excerpted stories retrieved from the Nexis database relating to "synthetic paper"; and (iii) printouts from some websites on the Internet referring to "synthetic paper." A few examples of the Nexis and Internet evidence are reproduced below (emphasis added):

Headline: Gear & Guides
...And if you spill a cup of coffee while
panning a day's journey, no problem.
They're printed on a non-toxic **synthetic
paper** with a special coating that's
designed to keep them dry and durable. ...
"San Jose Mercury News (California),"
November 2, 1003;

Headline: What's New With Boats
...About the product: Designed for recreational boaters, fisherman and divers, Waterproof Charts are printed on **synthetic paper**. "Asbury Park Press," July 11, 2003;

Headline: Local Artist Brings New Style, Techniques To Canvas
...The latest endeavor for Mailloux is using Yupo paper, a smooth, **synthetic paper** that feels like plastic to the touch. ... "Journal and Courier (Lafayette, IN)," May 30, 2003;

Synthetic Substrates
Durable films that feel like paper are widely used in labels and tags, as well as in emerging applications.

...

Brands and hybrids
"**Synthetic paper** is a fancy name for plastic film with a coating on it, typically," says Steve Nimz, president of Protect-All Print Media...
www.labelandnarrowweb.com; and

Synthetic Paper Industry
Publication Date: April 2001
Pages: 138
Price: \$3967.50
Description:
Synthetic papers are specially treated plastic films designed to be used by most printing processes. These plastic-type papers are especially useful where moisture and/or contamination would damage traditional paper, and are finding increasing use in labels, tags, maps, menus, posters, manuals, books, covers, ID and other cards, etc. ...
www.bbcresearch.com.

Applicant argues that the Examining Attorney has established only that "synthetic paper" is generic

according to common usage; that the Examining Attorney has not demonstrated the word SYNTHETEK names the genus or class of goods at issue here or that the relevant public understands the word to refer to that class of goods; that the mark SYNTHETEK is not the generic term for applicant's identified goods; that the suffix "TEK" in applicant's mark is the phonetic equivalent of "tech" and could refer to "technical"; and that applicant's applied-for mark is capable of functioning as a mark and is entitled to registration on the Supplemental Register.

The USPTO bears the burden of proving that the proposed trademark is generic, and genericness must be demonstrated through "clear evidence." See *In re Merrill Lynch, Pierce, Fenner, & Smith, Inc.*, 828 F.2d 1567, 4 USPQ2d 1141 (Fed. Cir. 1987); and *In re Analog Devices Inc.*, 6 USPQ2d 1808 (TTAB 1988), *aff'd*, *unpubl'd*, but appearing at 10 USPQ2d 1879 (Fed. Cir. 1989). The evidence of the relevant public's perception of a term may be acquired from any competent source, including newspapers, magazines, dictionaries, catalogs and other publications. See *Magic Wand Inc. v. RDB Inc.*, 940 F.2d 638, 19 USPQ2d 1551 (Fed. Cir. 1991); and *In re Leatherman Tool Group, Inc.*, 32 USPQ2d 1443 (TTAB 1994).

The test for determining whether a designation is generic, as applied to the goods or as used in connection with the services in an application, turns upon how the term is perceived by the relevant public. See *Loglan Institute Inc. v. Logical Language Group, Inc.*, 962 F.2d 1038, 22 USPQ2d 1531 (Fed. Cir. 1992). Determining whether an alleged mark is generic involves a two-step analysis: (1) what is the genus of the goods or services in question? and (2) is the term sought to be registered understood by the relevant public primarily to refer to that genus of goods or services? See *In re The American Fertility Society*, 188 F.3d 1341, 51 USPQ2d 1832 (Fed. Cir. 1999); and *H. Marvin Ginn Corporation v. International Association of Fire Chiefs, Inc.*, 782 F.2d 987, 228 USPQ 528 (Fed. Cir. 1986).

In this case, while there is clear evidence that the phrase "synthetic paper" is generic for a particular type of plastic film used for a wide variety of products, there is no evidence that the word SYNTHETEK is the name of the genus for "synthetic paper." That is, the Nexis and Internet evidence does not establish that the term SYNTHETEK names the genus of applicant's involved goods. In fact, the stories retrieved from the Nexis database and

the websites from the Internet do not show use of SYNTHETEK.

As the Examining Attorney stated in the final refusal: "The evidence previously attached was located using the applicant's identification of goods, e.g., 'synthetic paper.'" Of course, the issue is whether the applied-for mark is generic, and for whatever reasons, the Examining Attorney made no searches on Nexis or the Internet for the term comprising the applied-for mark, SYNTHETEK.

With regard to the second prong of the genericness test, the record is also devoid of evidence as to how the relevant purchasers and users would perceive the term SYNTHETEK in relation to applicant's identified goods, "synthetic paper."

Even assuming "SYNTHETEK" is a phonetic misspelling of the word "synthetic," we find the case now before us distinguishable from the cases cited by the Examining Attorney involving misspellings of terms held to be generic. In the cases cited by the Examining Attorney, the misspelled word mark was the generic name for the goods. For example, *In re Stanbel Inc.*, 16 USPQ2d 1469 (TTAB 1990), *aff'd unpub'd* but appearing at 20 USPQ2d 1319 (Fed. Cir. 1991) (ICE PAK held generic for nontoxic reusable ice substitute for use in food and beverage coolers); and *In re*

Ser. No. 78262721

Hubbard Milling Co., 6 USPQ2d 1239 (TTAB 1988) (MINERAL-LYX held generic for molasses-based feed supplement for livestock animals containing minerals).

Decision: The refusal to register on the Supplemental Register is reversed.